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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/043,837	01/09/2002	Yoshio Ikura	MAT-8221US	1180
7590	11/21/2005		EXAMINER	
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Valley Forge, PA 19482-0980			ART UNIT PAPER NUMBER	
			2662	
DATE MAILED: 11/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/043,837	IKURA, YOSHIO
Examiner	Art Unit	
Mohammad S. Adhami	2662	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### **Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

1) Responsive to communication(s) filed on 14 March 2005.

2a) This action is FINAL.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

4)  Claim(s) 1-8 is/are pending in the application.  
4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.  
5)  Claim(s) \_\_\_\_\_ is/are allowed.  
6)  Claim(s) 1-8 is/are rejected.  
7)  Claim(s) \_\_\_\_\_ is/are objected to.  
8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

9)  The specification is objected to by the Examiner.

10)  The drawing(s) filed on 25 March 2002 is/are: a)  accepted or b)  objected to by the Examiner.

    Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

    Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \* c)  None of:  
1.  Certified copies of the priority documents have been received.  
2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1)  Notice of References Cited (PTO-892)  
2)  Notice of Draftsperson's Patent Drawing Review (PTO-948)  
3)  Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.  
4)  Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.  
5)  Notice of Informal Patent Application (PTO-152)  
6)  Other: \_\_\_\_\_.  
\_\_\_\_\_

## DETAILED ACTION

### ***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 4 and 5 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. In claim 4 on line 9 the language "by receiving a dialing of the standard telephone as an IP address" is unclear. How does "a dialing" equate to an IP address?

### ***Claim Rejections - 35 USC § 102***

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

4. Claim 1 is rejected under 35 U.S.C. 102(e) as being anticipated by Itoi (US 6,456,625).

Itoi discloses "a terminal interface to which a terminal is connected" (Figure 3B reference number 312 is a terminal interface and reference number 313 is a terminal),

Itoi further discloses "a line interface connected to said network" (Figure 3B reference number 323 is a line interface that connected to network 102).

Itoi further discloses "a communication function unit for controlling at least a voice signal and an IP packet input/output in said terminal interface and said line interface" (Figure 3B reference number 322 and Col.9 lines 10-12 "A call control module 322...controls calls concerning the respective analog telephone sets...and internet phone devices").

Itoi further discloses "a conversion unit for converting said IP packet and said voice signal to each other" (Figure 3B reference number 309 and Col.9 lines 52-57 "the A/D conversion module 309...executes the analog-to-digital/digital-to-analog conversions of speech signals concerning this analog telephone set...and packet disassembling/assembling processes for digital speech signals").

Itoi further discloses "a memory for storing an IP address of said concentrator" (Figure 3A reference number 302).

Itoi further discloses "a connection establishing unit for establishing a connection between said terminal and another terminal connected to said network, by allowing said communication function unit to transmit an IP datagram including the IP address of said concentrator to said network" (Col.9 lines 40-45 "the address unit...automatically gives the data terminal...the set of the local IP address and TCP/UDP port number. As a results, the data terminal...is permitted to join in the LAN...and data communication over the data terminal...is actualized in the LAN").

***Claim Rejections - 35 USC § 103***

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 2-8 are rejected under 35 U.S.C. 103(a) as being unpatentable over Itoi in view of Elliot (US 6,754,181).

**Re claims 2 and 3:**

Itoi meets all the limitations of the parent claim.

Itoi does not explicitly disclose (Re claim 2) "a determining unit for determining whether or not said terminal connected to said terminal interface is capable of an IP communication, wherein...when said determining unit determines that said terminal is capable of the IP communication, an IP packet input from said line interface is outputted to said terminal interface as it is, and an IP packet input from said terminal interface is outputted to said line interface as it is; and...when said determining unit determines that said terminal is not capable of the IP communication, the IP packet input from said line interface is converted to a voice signal by said conversion unit and outputted to said terminal interface, while a voice signal input from said terminal interface is converted to an IP packet and outputted to said line interface", (Re claim 3) "wherein when said terminal connected to said terminal interface is a standard telephone, it is determined that said terminal is not capable of IP communication.

Elliot discloses (**Re claims 2 and 3**) “a determining unit for determining whether or not said terminal connected to said terminal interface is capable of an IP communication” (Col.89 lines 14-17 “A PC and a telephone is used to receive and make calls. In this case, a user profile will contain information that allows the DAP and Directory Service to make a determination whether to send an incoming call to the PC or to the telephone” where if the call is determined to be sent to a PC it is IP capable and when there is a telephone the terminal is not IP capable), (**Re claim 2**) “when said determining unit determines that said terminal is capable of the IP communication, an IP packet input from said line interface is outputted to said terminal interface as it is, and an IP packet input from said terminal interface is outputted to said line interface as it is” (Col.75 lines 53-56 “The called user can answer the phone with a mouse click and the calling party then begins sending traffic directly to the IP address of the called party”), and (**Re claim 2**) “when said determining unit determines that said terminal is not capable of the IP communication, the IP packet input from said line interface is converted to a voice signal by said conversion unit and outputted to said terminal interface, while a voice signal input from said terminal interface is converted to an IP packet and outputted to said line interface” (Col.92 lines 7-11 “the ITG provides services to convert the IP packetized voice from the PC to voice over the PSTN. Similarly, the ITG will take the voice from the PSTN and convert it to the IP packetized voice for the PC”).

Itoi and Elliot are analogous because they both pertain to voice over Internet.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Itoi to include the above discussed limitations in the network as taught by Elliot in order to accommodate IP capable and non-IP capable terminals into a hybrid network and enable determination of each.

**Re claims 6-8:**

Itoi meets all the limitations of the parent claims.

Itoi does not explicitly disclose (**Re claim 6**) "wherein when said terminal connected to said terminal interface is a computer, it is determined that said terminal is capable of an IP communication", (**Re claim 7**) "wherein said concentrator allows an IP datagram transmitted from said computer pass as it is, to a terminal having an IP address designated by said computer", and (**Re claim 8**) "wherein when said computer establishes a connection, said concentrator transmits an IP datagram including an IP address of said computer to a terminal having IP address designated by said computer."

Elliot discloses (**Re claim 6**) "a determining unit for determining whether or not said terminal connected to said terminal interface is capable of an IP communication" (Col.89 lines 14-17 "A PC and a telephone is used to receive and make calls. In this case, a user profile will contain information that allows the DAP and Directory Service to make a determination whether to send an incoming call to the PC or to the telephone" where if the call is determined to be sent to a

PC it is IP capable and when there is a telephone the terminal is not IP capable), (Re **claim 7**) "wherein said concentrator allows an IP datagram transmitted from said computer pass as it is, to a terminal having an IP address designated by said computer" (Col.79 lines 57-58 "no translation of IP encoded voice to PCM is required, indeed the dial out will use TCP/IP over PPP." OR Col.75 lines 53-56 "The called user can answer the phone with a mouse click, and the calling party then begins sending traffic directly to the IP address of the called party"), and (Re **claim 8**) "wherein when said computer establishes a connection, said concentrator transmits an IP datagram including an IP address of said computer to a terminal having IP address designated by said computer" (Col.93 lines 3-4 "The software package sends a message to a directory service to register the computer" where the message contains 40-43 "The IP address identifying the port that is being used to connect this computer to the network. This address will be used by other IP telephony software packages to establish a connection to this computer.").

Itoi and Elliot are analogous because they both pertain to voice over Internet.

It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Itoi to include the above discussed limitations in the network as taught by Elliot in order to incorporate a computer terminal into the hybrid telephony network of Itoi.

**Re claim 4 (as best understood):**

Itoi discloses "wherein by receiving a dialing of the standard telephone as an IP address of a call destination, the connection to a terminal having the IP address of the call destination is established" (Col. 1 lines 46-50 "a party to be talked to over the internet phone is designated by any of a scheme wherein the LAN address (IP address) and a domain name are used as they are, a scheme wherein a number registered and managed on the internet phone side beforehand is dialed" and Col.3 lines 52 –55 "the analog telephone set is permitted to join in the LAN telephone network, and speech over the analog telephone set is actualized in the LAN telephone network).

**Re claim 5 (as best understood):**

Itoi discloses "when the connection is established, said concentrator transmits the IP datagram including the IP address of said concentrator to the terminal having the IP address of the call destination" (Col.7 lines 51-53 "A common global IP address is a LAN address (IP address) which is given to the LAN telephone switching apparatus").

***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Feinberg (US 6,798,745,) shows voice over the Internet. Bouret (US App 2004/0042414) shows checking compatibility between callers. Han (US App 2003/076817)

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Mohammad S. Adhami whose telephone number is (571)272-8615. The examiner can normally be reached on Monday-Friday 8-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hassan Kizou can be reached on (571)272-3088. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

MSA 11/10/2005



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